

RECEIVED
CENTRAL FAX CENTER

SEP 09 2005

OFFICIAL

CARDINAL LAW GROUP

1603 Orrington Avenue/Suite 2000
Evanston, Illinois 60201
Telephone 847 - 905 - 7111
Facsimile 847 - 905 - 7113

Date: SEPTEMBER 9, 2005

To: EXAMINER SWEARINGEN, JEFFREY R.
U.S. PATENT AND TRADEMARK OFFICE

Fax #: (571) 273-8300

From: FRANK C. NICHOLAS
Phone #: (847) 424-2521

Client/Matter No.: AUS920010444US1 (9000/48)

of Pages: 19

(including cover sheet)

IF YOU HAVE ANY PROBLEMS RECEIVING THIS MESSAGE, PLEASE CALL 847/905-7111, Ext. 112 AND ASK FOR JENNIFER CRUZ

THIS MESSAGE IS INTENDED ONLY FOR THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. IT MAY CONTAIN PRIVILEGED, CONFIDENTIAL, ATTORNEY WORK PRODUCT, OR TRADE SECRET INFORMATION WHICH IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAWS. IF YOU ARE NOT THE INTENDED RECIPIENT, OR AN EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE (AND ALL COPIES) TO US BY MAIL AT THE ABOVE ADDRESS. WE WILL REIMBURSE YOU FOR POSTAGE.

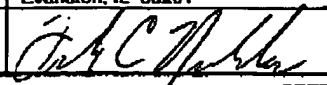
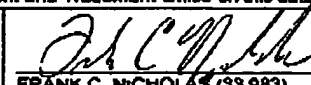
11/04/01 (10-47) Approved for use through 10/01/01. One USPTO-14571 Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 1995, the Patent and Trademark Office is required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Attorney Docket No.	AUS920010444US1 (900048)
	Application Number	09/996,130
	Filing Date	NOVEMBER 28, 2001
	First Named Inventor	DAVID B. KUMHYR
	Group Art Unit	2145
	Examiner	SWERINGEN, J. R.

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Status Letter <input type="checkbox"/> One-Month Petition for Extension of Time Request (dup) <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, art <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Assignment Papers <input type="checkbox"/> Drawings <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Petition Routing Slip (PTO/SB/99) and Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Express Abandonment Under 37 CFR 1.138 <input type="checkbox"/> Request of Refund	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Brief (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Post Card Receipt <input type="checkbox"/> Additional Enclosure(s) (please identify below) <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		
<input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		

CALCULATION OF FEE

				Small Entity		Large Entity		
	Claims After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		0	x \$25=	0	x \$50=	
Indep.		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=	—	+ \$360=	
					total add'l fee	\$ 0	total add'l fee	\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1803 Orlington Avenue, Suite 2000 Evanston, IL 60201		
Signature		Date	September 9, 2005
CERTIFICATE OF FACSIMILE			
I hereby certify that this correspondence is being transmitted via facsimile to (571) 273-8300 to the U.S. Patent and Trademark Office on this date: September 9, 2005			
Signature		Date	September 9, 2005
FRANK C. NICHOLAS (33,983)			

RECEIVED
CENTRAL FAX CENTER

SEP 09 2005

Certificate of Facsimile
I hereby certify that this correspondence is being transmitted
by facsimile to (571) 273-8300 to the United States
Patent and Trademark Office on this date: September 9, 2005
Date of Facsimile

FRANK C. NICHOLAS (33,983)



Signature

September 9, 2005

Date of Signature

PATENT
Case No. AUS920010444US1
(9000/48)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:

DAVID B. KUMHYR, ET AL.

Serial No.: 09/996,130

Filed: NOVEMBER 28, 2001

Title: ALLOCATING DATA OBJECTS
STORED ON A SERVER SYSTEM

Examiner: SWEARINGEN, JEFFREY R.

Group Art Unit: 2145

Conf. No.: 1438

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Brief on Appeal as follows:

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 2 of 16

TABLE OF CONTENTS

1.	Real party in interest	3
2.	Related appeals and interferences	4
3.	Status of claims	5
4.	Status of amendments	6
5.	Summary of claimed subject matter	7
6.	Grounds of rejection to be reviewed on appeal	8
7.	Argument	9
CONCLUSION		12
Claims appendix		13
Evidence appendix		16
Related proceedings appendix		16

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 3 of 16

1. REAL PARTY IN INTEREST

The real party in interest is Assignee International Business Machines Corporation, a corporation having an office and a place of business at Armonk, New York 10504.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 4 of 16

2. RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 5 of 16

3. STATUS OF CLAIMS

Claims 1-21 are currently pending in the application and stand finally rejected under 35 U.S.C. §103(a) as unpatentable over United States Patent 6,029,195 to Herz ("Herz") in view of United States Patent 6,789,170 to Jacobs ("Jacobs"). Claims 1-21 are on appeal. See, the Appendix.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 6 of 16

4. STATUS OF AMENDMENTS

All previously filed amendments have been entered in the application.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 7 of 16

5. SUMMARY OF CLAIMED SUBJECT MATTER

At least one user group is provided 60, and tag information for data objects is determined 61. At least one group interest for the user group is determined 64. If there is correspondence between the tag information and the group interest, data objects including tag information of the group interest are placed into a server cache 66. See, e.g. FIG. 3 and page 2, line 14 to 31 of the specification.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 8 of 16

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Are claims 1-21 unpatentable over Herz in view of Jacobs under 35 U.S.C. §103(a)?

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 9 of 16

7. ARGUMENTS

The §103(a) rejections of claims 1-21 as unpatentable over Herz in view of Jacobs are traversed. In order to maintain this rejection, each and every element of the claims must be taught or suggested, in at least as great detail as claimed, by the references, alone or in combination.

In short, Jacobs teaches a system and method for customizing cached data including a method for configuring data that *is to be cached* (i.e., the computer already knows that a piece of data is going to be cached) rather than a method of determining *whether* to cache a piece of data. See, ¶31 of the May 4, 2005 office action. Therefore, Jacobs cannot combine with any reference, much less Herz, to teach determining whether the tag information corresponds to the group interest and if there is correspondence placing data objects including tag information of said group interest into the cache as claimed in claims 1, 11, and 21. The teachings of Jacobs do not address determining whether to cache information, and therefore, Jacobs teaches away from the claimed elements.

Additionally, Herz in view of Jacobs fails to teach or suggest "providing at least one user group" or "determining at least one group interest for the user group" as claimed in independent claims 1, 11, and 21. Contrary to the Examiner's assertion, Herz merely discloses that attributes for a single user are maintained. "[A] profile holding *that user's attributes*, including age/zip code/etc. is termed a user profile" Herz, column 4, lines 54-55 (emphasis added). The Examiner correctly does not rely on Jacobs for such a teaching, and Jacobs does not cure this defect.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 10 of 16

At most, Herz teaches "the information delivery process in the preferred embodiment is based on determining the similarity between a profile for the *target object* and the *profiles of target objects* for which a user (or a similar user) has provided positive feedback in the past." See, column 6, lines 38-43, emphasis added. Thus, Herz does not teach determining a group interest for a *user group* – only comparing profiles for *target objects*. Indeed, by teaching a comparison of profiles of *target objects*, Herz directly teaches away from determining at least one group interest for the user group. The Examiner correctly does not rely on Jacobs for such a teaching, and Jacobs does not cure this defect.

The Examiner correctly notes that Herz fails to teach or suggest placing data objects including tag information of said group interest into a server cache, and instead relies on Jacobs for such a teaching. However, claims 1, 11, and 21 actually require "determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache." The Examiner does not even suggest that Jacobs teaches such an element. Herz fails to cure this defect.

At most, Jacobs teaches that custom data may be inserted into cached information. Jacobs does not teach relating to determining whether tag information corresponds to a group interest, and placing data objects including the tag information of said group interest into a server cache if there is correspondence.

Additionally, the Examiner's allegation of a motivation to combine falls far short of the strictures of §103(a). That Herz "gives motivation for the combination by stating users should be able to access relevant information without expending an excessive amount of time and energy" does not address the issue of whether one of ordinary skill in the art would be motivated to combine *these references* to solve that identified problem. The Examiner's formulation of the motivation illustrates the Examiner's reliance on impermissible hindsight. Even if the Examiner's allegation of Herz's teachings is correct, such a teaching does not contain any illustration of exactly how to provide a user access to relevant information without expending an excessive amount of time and energy.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 11 of 16

The motivation to combine references can only come from the references, be reasoned from common knowledge in the art, or from legal precedent. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01. In this case, the Examiner makes no showing that the motivation to combine the references comes from the references or that the motivation comes from legal precedent. Thus, the Examiner appears to be relying on "common knowledge in the art" – however, the Examiner makes no showing of what knowledge is common in the art, such as with official notice or an Examiner's Affidavit. As the motivation cannot come from the level of skill in the art, the Examiner needs to show *facts*, not allegations, to support that it is common knowledge in the art to combine these references. In view of the Examiner's failure to make such a showing, the §103(a) rejection must fall.

The mere fact that references *can* be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01. Merely alleging that each reference teaches a salutary teaching fails to satisfy the Examiner's burden.

Neither Herz nor Jacobs overcomes the deficiencies of the other reference, such that alone or in combination, the references fail to teach or suggest each and every claim limitation, and there is no motivation to combine the references.

Appellants request withdrawal of the rejections to independent claims 1, 11, and 21, as well as claims 2-10 and 12-20 depending directly or indirectly from independent claims 1 and 11 respectively.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 12 of 16


CONCLUSION

The Examiner's rejections have been obviated by the above remarks. Appellant respectfully submits that claims 1-21 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing remarks, favorable consideration and passage to issue of the present application are respectfully requested.

Dated: SEPTEMBER 9, 2005

Respectfully submitted,
DAVID B. KUMHYR, *et al.*

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



FRANK C. NICHOLAS
Registration No. 33,983
Attorney for Appellants

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 13 of 16

CLAIMS APPENDIX

1. Method of allocating data objects stored on a server system comprising:
providing at least one user group;
determining tag information for the data objects;
determining at least one group interest for the user group;
determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache.
2. The method of claim 1 wherein the data object includes a Web page.
3. The method of claim 2 wherein the Web page comprises information provided as hypertext mark-up language (HTML) or extensible mark-up language (XML), including tag information provided as hypertext transfer protocol (HTTP).
4. The method of claim 1 wherein determining tag information comprises reading data object tag information.
5. The method of claim 1 wherein determining tag information comprises generating data object tag information.
6. The method of claim 1 wherein determining at least one group interest for the user group comprises managing predictive data.
7. The method of claim 6 wherein managing predictive data comprises considering static predictions.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 14 of 16

8. The method of claim 6 wherein managing predictive data comprises considering access patterns.

9. The method of claim 1 wherein determining whether the tag information corresponds to the group interest comprises determining interest match information.

10. The method of claim 1 wherein determining whether the tag information corresponds to the group interest comprises determining a pertinence score.

11. A computer usable medium including a program for allocating data objects stored on a server system comprising:

computer readable program code for providing at least one user group;

computer readable program code for determining tag information for the data objects;

computer readable program code for determining at least one group interest for the user group; and

computer readable program code for determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache.

12. The computer usable medium of claim 11 wherein the data object comprises a Web page.

13. The computer usable medium of claim 12 wherein the Web page comprises information provided as hypertext mark-up language (HTML) or extensible mark-up language (XML), including tag information provided as hypertext transfer protocol (HTTP).

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 15 of 16

14. The computer usable medium of claim 11 wherein determining tag information comprises reading data object tag information.
15. The computer usable medium of claim 11 wherein determining tag information comprises generating data object tag information.
16. The computer usable medium of claim 11 wherein determining at least one group interest for the user group comprises managing predictive data.
17. The computer usable medium of claim 16 wherein managing predictive data comprises considering static predictions.
18. The computer usable medium of claim 16 wherein managing predictive data comprises considering access patterns.
19. The computer usable medium of claim 11 wherein determining whether the tag information corresponds to the group interest comprises determining interest match information.
20. The computer usable medium of claim 11 wherein determining whether the tag information corresponds to the group interest comprises determining a pertinence score.
21. System for allocating data objects stored on a server system comprising:
 - means for providing at least one user group;
 - means for determining tag information for the data objects;
 - means for determining at least one group interest for the user group;
 - means for determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache.

September 9, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
Page 16 of 16

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.